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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,522	09/15/1999	JEAN-PIERRE ISSA	JHU1590	1197

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/398,522

Applicant(s)

ISSA, JEAN-PIERRE

Examiner

Jeanine A Goldberg

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 March 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 10,16-24 and 33-38.

Claim(s) withdrawn from consideration: 1-9 and 25-32.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
10. ☐ Other: _____


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Continuation of 2. NOTE: The claims have been amended to recite "colorectal adenoma or a cancer other than a glioma by determining the methylation status of one or both of a first and second region". These limitations which are directed to exclude glioma are newly added and would require further consideration. Furthermore, the limitation of a first and second region are newly added, because it is unclear whether these regions are the regions set forth in the specification as Region 1 and Region 2 or whether this first and second region are additional regions. Moreover, the Claim has been amended to broaden the scope of the claim such that no SEQ ID NO: s are required. Therefore, the claims have been amended such that further search and considerations are required. .

Continuation of 5. does NOT place the application in condition for allowance because: It is noted that the arguments are directed solely to the newly amended claims which have not been entered. Therefore, the arguments are moot. However in an effort to further prosecution, the examiner has provided a short response to the arguments.

The response asserts that the newly amended claims are supported by the specification. The amendment of the claims, however, with respect to "a first region and a second region" do not make clear that these regions correspond to MINT31 or Region 1 and 2 identified by SEQ ID NO: 35 and 36. Therefore, the arguments are not found persuasive.

With respect to methylation in colorectal adenoma or a cancer other than glioma, the specification nor the art support the broad scope of the invention. The art does not appear to suggest that CACNA1G methylation is significantly associated with oral squamous cell carcinomas or AML. As discussed above, the claim is not clearly directed to Region 1 and 2 described in the specification as asserted by the response. The response argues that MINT31 corresponds to Regions 1 and 2 of the CACNA1G CpG island. It is unclear from the specification that this is in case the fact. The specification states that "The CACNA1G CpG island is 4 kb, and is larger than many typical CpG islands. MINT31 corresponds to the 5' edge of the island while CACNA1G is in the 3' region." This does not appear to state that Regions 1 and 2 are MINT31. Moreover, the art indicates that MINT31 may not be part of a gene. Therefore, comparison of the art's MINT31 and Regions 1 and 2 of the specification is unclear.